

### REMARKS

Claims 27 and 29 have been amended to more clearly recite a feature of Applicants' invention. Support for the amendments to claims 27 and 29 may be found throughout the specification and Figures. No new matter has been added. Claim 29 has also been amended to correct an informality in the claim numbering. Upon entry of this Amendment, claims 27-29 remain pending.

In the Office Action dated September 30, 2005, claims 27 and 29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Roberts (U.S. Patent No. 5,498,455). Applicants respectfully traverse this rejection.

Claim 27 recites a lamination product that includes, *inter alia* "a substrate having pressure sensitive adhesive material coated on a first portion and a second portion of one side of the substrate; ... and a transparent laminate secured to the substrate at the second portion of the one side with the pressure sensitive adhesive material, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material." Claim 27 is patentable over Roberts because Roberts does not disclose or suggest all of the features of claim 27.

Roberts discloses a mount (M) for mounting an object, such as a picture (P). *See* Roberts at col. 6, lns. 26-35 and FIG. 1. An adhesive (AD) covers a portion of the mount (M) and a release sheet (118) completely covers the adhesive (AD). *See* Roberts at col. 6, lns. 36-48 and FIGs. 1-3. A template (54) may be used to help align the picture (P) with the mount (M). *See* Roberts at col. 6, lns. 49-56, and FIG. 1. As is clearly described by Roberts, the template (54) is coated with a light-tack adhesive (LAD) along its top edge to hold the template (54) onto the mount (M). *See* Roberts at col. 7, lns. 18-26. The light-tack adhesive is clearly coated on the template (54) and not the mount (M). Roberts explains that the light-tack adhesive (LAD) has similar characteristics to the adhesive that is coated on removable adhesive notes. *See* Roberts at col. 7, lns. 20-23. Hence, Roberts clearly teaches that the template (54) is momentarily attached to the mount (M) with its own adhesive (LAD) to help align the picture (P) relative to the mount (M). The template (54) of Roberts is not attached to the mount with the same adhesive that covers a portion of the mount. This is because the template (54) is only intended to be a temporary guide, and is not intended to be permanently affixed to the mount (M). As such, Roberts does not disclose or suggest a lamination product that includes – at least - a substrate having pressure sensitive adhesive material coated on a first portion and a second portion of one side of the substrate, and a transparent laminate

secured to the substrate at the second portion of the one side with the pressure sensitive adhesive material (i.e., the pressure sensitive material that is on the one side of the substrate).

Accordingly, Applicants respectfully submit that claim 27 is patentable over Roberts, and respectfully request that the rejection to claim 27 be withdrawn.

Independent claim 29 recites a method for laminating a document in a lamination product having, *inter alia*, a substrate having pressure sensitive adhesive material coated on a first portion and a second portion of one side of the substrate, release material covering the first portion of the one side and exposing the second portion of the one side, and a transparent laminate secured to the substrate at the second portion of the one side with the pressure sensitive adhesive material, the method comprising, *inter alia*, placing the document between the laminate and the substrate, and pressing the document and laminate against the exposed adhesive of the first portion. Roberts does not even disclose or suggest a method for laminating a document in a lamination product, let alone one that includes all of the features of claim 29.

Roberts is discussed above. As discussed above, Roberts teaches the use of a release sheet and a template to secure objects onto a mount. Roberts does not disclose or suggest a method for laminating a document in a lamination product that includes a substrate having a pressure sensitive adhesive material coated on a first portion and a second portion of one side of the substrate, and a transparent laminate that is secured to the substrate with the pressure sensitive material. The template (54) of Roberts is temporarily attached to the mount (M) with a light-tack adhesive (LAD) that is coated on the template (54) (not the mount) to guide the positioning of the object being mounted to the mount (M). The light-tack adhesive (LAD) is different from the adhesive (AD) that is provided on the mount (M) and covered by the release sheet (118).

Moreover, Roberts does not disclose or suggest pressing the document and laminate against the exposed adhesive, as recited by claim 29. The template (54) of Roberts never comes into contact with the adhesive (AD) that is on the mount (M), and therefore cannot be pressed against the exposed adhesive, as claimed in claim 29. The adhesive (AD) only covers an area that will be covered by the object being mounted. Thus, only the object that is being mounted can be pressed against the exposed adhesive.

Because Roberts does not disclose or suggest all of the features of claim 29, Applicants respectfully submit that claim 29 is patentable over Roberts, and respectfully requests that the rejection to claim 29 be withdrawn.

In the Office Action, claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts in view of McVoy et al. (U.S. Patent No. 3,827,726). Applicants respectfully traverse this rejection. The Examiner has not established a *prima facie* case of obviousness.

Claim 28 depends from claim 27. As discussed above, claim 27 is patentable over Roberts. Moreover, Roberts teaches that the surface area of the adhesive (AD) that is provided on the mount (M) is less than the surface area of the object being mounted to the mount (M). *See e.g.*, FIGs. 3, 7B, 8B, 12A, and 12B, and col. 7, lns. 40-47. Providing an object that has a surface area that is smaller than the surface area of the adhesive goes against the teachings of Roberts, because Roberts is directed to mounting an object onto a mount, such as a card. *See Roberts* at Abstract. If the surface area of the adhesive were greater than the surface area of the object being mounted, the result would be exposed adhesive that would likely attract dirt and other undesirable objects onto the mount. Therefore, there would be no reason to modify Roberts as the Examiner proposes to do. There is simply no motivation to combine Roberts and McVoy et al., nor is there any expectation of success. The Examiner is using impermissible hindsight to cobble together these references, and has not established a *prima facie* case of obviousness.

Accordingly, Applicants respectfully submit that claim 28 is patentable over Roberts in view of McVoy et al., and respectfully request that the rejection be withdrawn.

All rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited. If any point remains at issue which the Examiner feels may best be resolved through a personal or telephone interview, please contact the undersigned at the telephone number below.

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Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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